

1 REMARKS

2 In the Office Action dated July 5, 2002, the Examiner
3 rejected claims 1-26 under 35 U.S.C. §§ 102, 103 and/or 112. In
4 the following remarks, applicant will respond to those rejections
5 and highlight the differences between the pending claims and the
6 cited references such that it becomes apparent to the Examiner
7 that these rejections should be reconsidered and withdrawn. With
8 respect to the §112 rejection, applicant has amended and/or
9 cancelled the pending claims in accordance with the Examiner's
10 comments, and wishes to thank the Examiner for calling these
11 issues to his attention.

12 Applicant firmly believes the above amendments and the
13 following comments will convince the Examiner that the rejection
14 of the pending claims under §102 and §103 should be reconsidered
15 and withdrawn. In particular, applicant would like to direct the
16 Examiner's attention to applicant's idea for an improved cosmetic
17 brush having a uniquely designed tuft of bristles for enhanced
18 applicability of eye make-up to the lashbed of the eyelids.
19 Specifically, the cosmetic brush according to the claimed
20 invention is an eyeliner brush having a unique tuft of bristles
21 that is much wider than it is thick and has bristles configured
22 such that the tuft has a tip portion having a curved shape so as
23 to conform to the shape and contour of the eyelash line.
24 Applicant is unaware of anything like this in the prior art, and

1 even the references relied on by the Examiner do not suggest the
2 applicant's novel invention. In short, applicant respectfully
3 submits that the Examiner's reliance on Dorf U.S. Patent No.
4 6,039,051 ("Dorf"), Takada et al. U.S. Patent No. D258,240
5 ("Takada"), Gueret U.S. Patent No. 5,765,573 ("Gueret"), and
6 Cervantes U.S. Patent No. 4,222,677 ("Cervantes") is misplaced --
7 as applicant's invention is very different from what is disclosed
8 therein.

9 Initially, the Examiner rejected claims 1, 3-4, 7-8, 14, and
10 16-24 under 35 U.S.C. §102(e) as being anticipated by Dorf.
11 Applicant respectfully submits that these claims are not
12 anticipated by Dorf. It is black letter law that to be
13 anticipatory, a prior art reference must disclose each and every
14 element of the claim or claims at issue -- Dorf falls far short
15 of this requirement.

16 Briefly, Dorf discloses a very different cosmetic brush
17 having bristles specially configured in a non-curved arrangement
18 (unlike in the claimed invention) for the application of make-up
19 to the cheek. Specifically, Dorf teaches a brush having bristles
20 that form a tuft that is contoured so that the approximate length
21 of the bristles vary across the width from a shorter side to a
22 longer side, such that a tapered portion is formed at each side
23 of the width (i.e., such that the tip or head of the brush when
24 viewed from the side appears rounded with the edges being

1 tapered). This is very different from the present invention.
2 That is, as is readily apparent, Dorf fails to disclose a
3 cosmetic brush having a tuft comprised of bristles that are
4 "aligned such that said bristles in a direction along said width
5 form a generally curved shape, such that said tuft at said tip
6 end is curved" in order to conform to the curved nature and
7 contour of the lashbed. In addition, Dorf fails to teach a brush
8 with bristles of substantially the same length. Moreover, it is
9 readily apparent that the brush according to Dorf cannot be used
10 effectively in the application of make-up to the eyelash line
11 like the claimed invention - the brush in Dorf is for the
12 application of make-up to the cheeks. Similarly, claims 3-4, 7-
13 8, 14, and 16-24, all depend from claim 1, and therefore each
14 include all of its limitations. Thus, Dorf fails to teach or
15 disclose every element of the claimed invention of at least
16 claims 3-4, 7-8, 14, and 16-24.

17 Next, the Examiner rejected claims 1-25 under 35 U.S.C.
18 §103(a) as being unpatentable over Takada in view of Gueret.
19 Applicant respectfully submits that the Examiner's understanding
20 of the claimed invention and/or the teachings of the cited
21 references is misplaced and that claims 1-25 are not rendered
22 obvious by the cited references, either alone or in combination.
23 Applicant further submits that, with the benefit of the teachings
24 of applicant's specification, the Examiner's rejection could only

1 be the result of hindsight reconstruction of the applicants'
2 invention. Moreover, even if the cited references were properly
3 combined, such combination still would not teach all of the novel
4 and non-obvious features of the present invention as claimed.

5 Applicant disagrees with the Examiner's opinion as to the
6 specific teachings of both Takada and Gueret. Applicant submits
7 that Takada simply discloses an ornamental design for the handle
8 of a cosmetic applicator having a tuft of bristles. Nowhere does
9 Takada teach or suggest a cosmetic brush comprising a tuft of
10 bristles configured in a curved pattern to conform to the contour
11 of the eyelid like the claimed invention.

12 Turning next to Gueret, in the opinion of the Examiner,
13 disclosed is a "device having a tuft of bristles 6 with a curved
14 tip 28 to conform to the shape of the user's eye and facilitate
15 the application of eye cosmetics (see Fig. 4b)." This view of
16 Gueret is incorrect as applied to the claimed invention for at
17 least two reasons. First, Gueret nowhere discloses a brush
18 having a tuft of bristles aligned in a curved pattern like the
19 claimed invention. Rather, the embodiment cited by the Examiner
20 comprises bristles having different lengths such that the tuft
21 has a concave shape when viewed from the side. Second, Gueret
22 discloses an applicator for applying mascara. In particular, the
23 bristles of the applicator are capable of loading mascara onto
24 the eyelashes along their longitudinal axis. The brush according

1 to Gueret is specifically designed to apply mascara to the
2 eyelashes. As such, it would not and infact does not have
3 bristles configured to apply make-up to the lashline of the
4 eyelid, which requires a very different brush - like the present
5 invention.

6 In short, Gueret fails to teach or disclose both the use of
7 a ferrule to secure bristles to a handle to form a brush as well
8 as a tuft of bristles configured whereby the tuft of bristles
9 aligned in a curved pattern along its width, which facilitates
10 the accurate and natural-looking application of eyeliner to the
11 lashline of the eyes. Moreover, a brush according to Takada or
12 Gueret, alone or in combination, cannot be used effectively in
13 the application of make-up to the lashline of the eyes like the
14 claimed invention. In addition, claims 2-25 all depend from
15 claim 1, and therefore each include all of its limitations.
16 Thus, Takada and Gueret fail to teach or disclose every element
17 of the claimed invention of at least claims 1-25.

18 Finally, the Examiner rejected claims 1 and 26 under 35
19 U.S.C. §103(a) as being unpatentable over Cervantes in view of
20 Dorf and Gueret. Here too applicant submits that the Examiner's
21 understanding of the present invention and/or the teachings of
22 the cited references is misplaced and that claims 1 and 26 are
23 not rendered obvious by the cited references, either alone or in
24 combination. Applicant further submits that, with the benefit of

1 the teachings of applicant's specification, the Examiner's
2 rejection could only be the result of hindsight reconstruction of
3 the applicants' invention. Moreover, even if the cited
4 references were properly combined, such combination still would
5 not teach all of the novel and non-obvious features of the
6 present invention as claimed.

7 With respect to the Examiner's arguments as to Dorf and
8 Gueret, applicant reiterates its position as stated above. As to
9 Cervantes, applicant respectfully disagrees with the Examiner's
10 understanding of its teachings as they apply to the present
11 claimed invention.

12 Regarding Cervantes, disclosed is a tool for the application
13 of a fluent material. Specifically, the tool according to
14 Cervantes comprises a bent handle to facilitate the application
15 of liquid eye make-up where the bristles are tapered. Again,
16 this is not the claimed invention. That is, as is readily
17 apparent, nowhere does Cervantes teach or suggest using a ferrule
18 to secure bristles to a handle to form a brush, nor does
19 Cervantes disclose a tuft of bristles aligned in a curved pattern
20 to conform to the contour of the lashline of the eyes whereby
21 their positions form a curved or arched structure. Also, as is
22 readily apparent from a careful review of Cervantes, the brush
23 disclosed therein cannot be used effectively in the application
24 of eyeliner to an eyelid like the claimed invention.

1 In sum, Cervantes fails to teach or disclose every element
2 of the claimed invention of the pending claims. In fact, none of
3 the cited references (Cervantes, Dorf, or Gueret) teach or
4 suggest a tuft of bristles aligned in a curved pattern to conform
5 to the contour of the lashline of the eyes whereby their
6 positions form a curved or arched structure to facilitate the
7 accurate and natural-looking application of eyeliner. Therefore,
8 applicant submits that the rejection of claims 1 and 26 as being
9 unpatentable over Cervantes or Dorf or Gueret should be
10 reconsidered. Upon closer review of the cited references and in
11 view of the amendments and remarks made herein above, applicant
12 submits that it will be apparent to the Examiner that his
13 rejection should be withdrawn.

14 Further, the applicant respectfully points out that the
15 cited references provide no basis for the obviousness rejection
16 set forth by the Examiner. Rather, the obviousness rejection
17 could only be the result of a hindsight view with the benefit of
18 the applicant's specification. However,

19 "To draw on hindsight knowledge of the patented
20 invention, when the prior art does not contain or
21 suggest that knowledge, is to use the invention as a
22 template for its own reconstruction -- an illogical and
23 inappropriate process by which to determine
24 patentability. The invention must be viewed not after
25 the blueprint has been drawn by the inventor, but as it
26 would have been perceived in the state of the art that
27 existed at the time the invention was made." (citations
28 omitted) *Sesonics v. Aerosonic Corp.*, 38 U.S.P.Q. 2d.
29 1551, 1554 (1996).

1 Second, the obviousness argument advanced by the Examiner is
2 not legally proper -- on reconsideration the Examiner will
3 undoubtedly recognize that such a position is merely an "obvious
4 to try" argument. All of the brushes according to Dorf, Gueret,
5 Takada and Cervantes, are unsuitable for use on the lashline and
6 none of them utilize a curved tuft of bristles that conforms to
7 the contour of the eyelid like the claimed invention. The
8 disclosure in the specification and claims of Dorf, Takada,
9 Gueret, and Cervantes do not reveal any functional or design
10 choices that could possibly include the applicant's invention.

11 Accordingly, it cannot be said that the present invention is
12 obvious in view of any of Dorf, Takada, Gueret or Cervantes. At
13 best it might be obvious to try such a combination. Of course,
14 "obvious to try" is not the standard for obviousness under 35
15 U.S.C. §103. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231
16 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

17 Under the circumstances, we respectfully submit that the
18 Examiner has succumbed to the "strong temptation to rely on
19 hindsight." *Orthpedic Equipment Co. v. United States*, 702 F.2d
20 1005, 1012, 217 USPQ 193, 199 (Fed.Cir. 1983):

21 "It is wrong to use the patent in suit as a
22 guide through the maze of prior art
23 references, combining the right references in
24 the right way so as to achieve the result of
25 the claim in suit. Monday morning
26 quarterbacking is quite improper when
27 resolving the question of nonobviousness in a
28 court of law." Id.

1 Applicant submits that the only "motivation" for the
2 Examiner's reliance on Dorf, Takada, Gueret or Cervantes is
3 provided by the teachings of applicant's own disclosure. No such
4 motivation is provided by Dorf, Takada, Gueret or Cervantes, nor
5 could there be, as Dorf, Takada, Gueret and Cervantes fail to
6 disclose a cosmetic brush that has a novel bristle arrangement
7 which efficiently and consistently applies eyeliner to the
8 eyelid.

9 Under the circumstances, we respectfully submit that the
10 Examiner has succumbed to the "strong temptation to rely on
11 hindsight." *Orthopedic Equipment Co. v. United States*, 702 F.2d
12 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983):

13 "It is wrong to use the patent in suit as a guide
14 through the maze of prior art references, combining the
15 right references in the right way so as to achieve the
16 result of the claim in suit. Monday morning quarter
17 backing is quite improper when resolving the question
18 of non-obviousness in a court of law." *Id.*

19 Applicant submits that the only "motivation" for the
20 Examiner's obviousness argument in view of the cited references
21 is provided by the teachings of applicant's own disclosure. No
22 such motivation is provided by the references themselves.

23 Therefore, as is evidenced by the above amendments and
24 remarks, the present invention, for the first time, discloses a
25 cosmetic brush having a tuft of bristles configured or aligned
26 such that their curved shape facilitates the accurate and
27 natural-looking application of eyeliner. A cosmetic brush such

1 as this is neither taught nor suggested anywhere in the prior
2 art, including Dorf, Takada, Gueret and Cervantes.

3 Applicant has amended the drawings to include new Figure 5.
4 The new drawing has been added to further clarify the non-obvious
5 structural and functional details of the invention as described
6 in the specification. No new subject matter has been added.

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10 CONCLUSION

11 In view of the foregoing, applicant respectfully submits
12 that the present invention represents a patentable contribution
13 to the art and the application is in condition for allowance.
14 Early and favorable action is accordingly solicited.

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Respectfully submitted,



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